

REMARKS

Claims 1, 2, and 8-17 have been amended. Claims 3-7 have been cancelled. Claims 1-2 and 8-17 are pending. Cancellation and amendment of the claims does not affect inventorship. Support for the amended claims is found in the original and previously amended claims, and in the Examples.

Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

Restriction

Applicants respectfully thank the Examiner for withdrawing the restriction requirement of 28 Marcy 2006.

Double Patenting

Claims 1, 2 and 7-17 were rejected on the basis of nonstatutory obviousness-type double patenting as being unpatentable in view of claims 1-27 of U.S. Patent No. 6,627,186. Claim 7 has been cancelled.

Applicant's have submitted herewith a signed terminal disclaimer over U.S. Patent No. 6,627,186. Applicant's submit that this rejection is overcome by the terminal disclaimer, and respectfully request that it be withdrawn.

35 USC § 112, first paragraph - Enablement

Claims 1, 2, 8, 16 and 17 have been rejected under 35 USC 112, first paragraph, as lacking enablement. The Examiner states that the specification "does not reasonably provide enablement for the broad genus of hG-CSF claimed." The Examiner further states that "there is no activity limitation in the claims."

The claimed variants recite both structure (i.e. substitutions at specific positions) as well as a function (i.e. increased thermal stability). Claim 1, as amended, recites "[a]n hG-CSF protein comprising two amino acid substitutions at positions 17 and 28 having increased stability as compared to SEQ ID NO: 2." The claim thus recites two specific substitutions in reference to a specific disclosed sequence. Claim 1 also recite the function "increased thermal stability."

Applicants submit that both the claimed substitutions are fully supported by the instant specification. For example, substitutions at position 17 is described in Figures 4 and 5, and page 13 line 38 through page 14 line 38. Substitutions at position 28 are described at pages 13-14, and page 29 line

11. A description of increased thermal stability may be found, for example, at Figure 13 and the associate section of the specification at page 31, lines 20-29. The description of Protein Design Automation® (PDA®) further augments the description of the claimed invention.

Applicants respectfully request that the claims are fully enabled by the specification. In light of the foregoing, the present ground for rejection be withdrawn.

35 USC § 112, first paragraph – written description

Claims 1, 2, 7, 8, 16 and 17 have been rejected as lacking written description under 35 USC § 112, first paragraph.

Claim 1, as amended, is fully supported by the specification. The specific claimed positions as compared to SEQ ID NO:2 are supported in the detailed description and examples as discussed above. Further, the recitation "increased thermal stability" is disclosed in Figure 13 and the associated examples. One of skill in the art would conclude that Applicants had possession of the claimed invention as of the filing date in satisfaction of the written description requirement.

Applicants respectfully request that this ground for rejection be withdrawn.

Specification

Applicants have amended the first paragraph of the instant application to recite the priority of the present application. Applicants respectfully request that this ground for objection be withdrawn.

Conclusion

Applicants believe the present application is in condition for allowance. Early favorable communication thereof is respectfully requested. Please direct any calls in connection with this application to the undersigned at (415) 781-1989.

DORSEY & WHITNEY LLP

Dated:

Sept 26, 2006

By:

[Signature]

Customer No.: 32940

555 California Street, Suite 1000

San Francisco, CA 94104-1513

Telephone: (415) 781-1989

Facsimile: (415) 398-3249

Timothy A. Worrall, Reg. No. 54,552 for
Robin M. Silva, Reg. No. 38,304